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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,682	02/10/2004	Rodolfo A. Morales	578492000510	3785
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MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018				
EXAMINER				
RYCKMAN, MELISSA K				
ART UNIT		PAPER NUMBER		
3773				
NOTIFICATION DATE		DELIVERY MODE		
10/18/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

EOOfficePA@mofo.com
drcaidwell@mofo.com
PatentDocket@mofo.com

Office Action Summary

Application No.

10/776,682

Applicant(s)

MORALES ET AL.

Examiner

MELISSA RYCKMAN

Art Unit

3773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-40 and 43-58 is/are pending in the application.
- 4a) Of the above claim(s) 49-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-40 and 43-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 3/22/11, 7/8/11
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/22/11 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant states each of the plurality of clips includes two loops. The specification and drawing states/shows eyelets (Fig. 8, spec. page 23 para. 0098) not loops.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-40 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brock (U.S. Pub. No. 2002/0087169) in view of Yoon (U.S. Patent No. 5,984,933).

Claim 37: Brock teaches a device for applying at least one clip to annular tissue of a heart valve (Fig. 32) the device comprising; a shaft having a proximal end and a distal end (342, Fig. 31); advance a tethered clip assembly from the shaft (Fig. 31, para. 262), wherein the tethered clip assembly has a first deployed configuration (Fig. 31) and a second deployed configuration (Fig. 32), the tethered clip assembly in the first deployed configuration (Fig. 32) comprising at least two clips wherein the clips each comprise two tissue- piercing legs (Fig. 31, 351, para. 262) joined by a loop, are separated by a first distance and coupled to a tether (312) that passes through the loops transversely to the legs, and wherein when the tethered clip assembly is in its second deployed configuration (Fig. 33) the tether is under longitudinal tension (para. 263) and the first distance is reduced to a second distance (para. 263 and 273), and wherein the at least two clips are in a closed tissue-piercing position and at least one clip is slidable on the tether (sliding motion between the tether and clip) when the tethered clip assembly is in both its first and second deployed configuration.

Brock teaches the claimed invention however does not specify a pushing member. However, Yoon teaches, in the same field of endeavor, a pushing member (2458, Fig. 49) within the distal portion of the shaft (at distal portion when less clips, Fig. 49) with a tether (2418) within a channel of the pushing member (Fig. 49) for the purpose of aiding in the delivery of the clips. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pusher member of Yoon with the device of Brock in order to aid in the delivery of the clips.

Claims 38-40: Brock teaches the device further comprises a clip crimping member (distal portion of 352, Fig. 31), a plurality of clips (Fig. 31), each plurality of clips is couple to the tether (312).

Claim 43: Brock teaches the claimed invention but only specifies one loop on each clip and one tether connecting the clips, however Yoon teaches, in the same field of endeavor, each of the plurality of clips includes two eyelets (2228), and two tethers (2218a and 2218) has parallel segments passing through both eyelets of each clip (Fig. 44) for the purpose aiding in the clip delivery. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the two tethers and two loops of Yoon with the device of Brock as this aids in correct placement of the clips in the tissue of the heart valve.

Claim 44: Brock teaches a system for applying at least one clip to annular tissue of a heart valve, comprising: the device as claimed above in claim 37; and a stabilization device (334, Fig. 32) to capture and immobilize the annular tissue relative to the remainder of the heart (265).

Claims 45-47: Brock teaches a visualization device capable of providing direct visualization to the annular tissue (para. 272), including an ultrasonic imaging transducer and an optical viewing element disposed within a transparent element (para. 115).

Claim 48: Brock teaches an inflatable balloon with transparent medium (para. 265).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Ryckman whose telephone number is (571)272-9969 and email is Melissa.Ryckman@uspto.gov. The examiner can normally be reached on Monday-Friday 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Corrine McDermott, at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If there are any inquiries that are not being addressed by first contacting the Examiner or the Supervisor, you may send an email inquiry to

TC3700_Workgroup_D_Inquiries@uspto.gov.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR
/Melissa Ryckman/
Examiner, Art Unit 3773

/CORRINE M MCDERMOTT/
Supervisory Patent Examiner, Art Unit 3773